Remarks

Claims 2, 4, 14-17, 19-28, 41-49, 73, 79, and 80 were previously pending in this Application before entrance of the present Amendment. Claims 2, 4, 14-17, 19-28, 41-49, 73, 79, and 80 stand rejected by the Examiner, and claims 29-31, and 74 have been withdrawn form consideration by the Examiner at this time. By this Amendment, claims 2, 14, 15, 17, 20, 24, 79, and 80 have been amended, and claims 1, 3-13, 18, 32-78 have been previously canceled or are canceled by the present Amendment. Support for the amendments to claims 2 and 79 can be found in original claim 2 and in the examples in the present Application. Claim 80 has been amended to correct typographical errors and remove non-elected subject matter. The amendments to the remaining claims correct dependencies, typographical errors, and maintain consistency based on the amendments to claim 2. Applicant submits that no new matter has been added to the Application by this Amendment. Claims 2, 14-17, 19-28, and 79-80 are pending in this case and under consideration by the Examiner. Applicant reserves the right to pursue subject matter canceled from the pending claims in a future application claiming priority to the present application. Applicant respectfully requests reconsideration of this case as amended.

Each of the rejections levied by the Examiner in the outstanding Office Action is discussed in turn below.

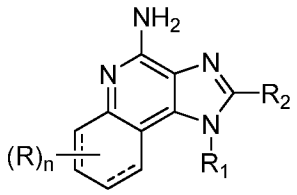
Rejection under 35 U.S.C. § 112

The Examiner has rejected the pending claims under 35 U.S.C. § 112, first paragraph, for lack of enablement. The Examiner maintains that the "claim still contains numerous variables and substitution. X′, R_3 and R_4." Applicant disagrees. However, solely to facilitate the prosecution of the present application, Applicant has amended the pending claims, particularly claims 2 and 79, thus obviating the present rejection. The number of possibilities for $R_{1\text{-}1}$, Y, R_2, and R_3 have been substantially reduced in line with the examples in the present application. One of ordinary skill in the art could make and use the compounds as claimed in the present Application without undue experimentation based on the teachings in the Application. Accordingly, withdrawal of the rejection under § 112 for lack of enablement is respectfully requested.

Rejection under 35 U.S.C. § 103

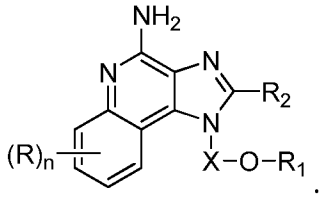
The Examiner has maintained the rejection under 35 U.S.C. § 103 over U.S. Patents 6,573,273 and 6,656,938 (Crooks *et al.*). Applicant respectfully disagrees.

The '273 patent teaches compounds of the general formula:



wherein R_1 is –alkyl-NR_3-CO-O-R_4 or alkenyl-NR_3-CO-O-R_4.

The'938 patent teaches compounds of the general formula:



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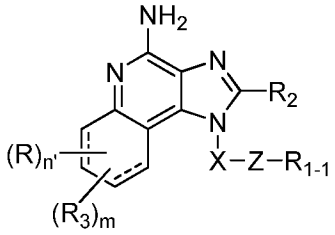
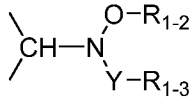
The instant Applicant claims compounds of the general formula



wherein X is an alkyl linker and Z is -C(=N-O-R_{1-2})- or 

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Neither of the patents to Crooks *et al.* teaches the claimed compounds of the present Application given the substituent Z. Furthermore, Applicant respectfully submits that the claimed invention is not obvious in view of neither the '273 patent or the '938 patent. The structural differences between the claimed compounds of the present Application and the ones from the '273 and '938 patents are significant and are not obvious, and there are no teachings or suggestions pointed out by the Examiner to modify the compounds of the cited patents to come up with the claimed compounds of the present Application.

The Federal Circuit recently ruled that a structural similarity *and* some motivation in the prior art are both required to establish a *prima facie* case of obviousness in the chemical arts. *Takeda Chem. Indus., Ltd. v. Alphapharm Pty., Ltd.*, 492. F.3d 1350 (Fed. Cir. 2007). Applicant respectfully submits that the Examiner's rejection does not satisfy these two requirements.

> We have held that "structural similarity between claimed and prior art subject matter, proved by combining references or otherwise, where the prior art gives reason or motivation to make the claimed compositions, creates a prima facie case of obviousness." *Dillon*, 919 F.2d at 692. In addition to structural similarity between the compounds, a prima facie case of obviousness also requires a showing of "adequate support in the prior art" for the change in structure. *In re Grabiak*, 769 F.2d 729, 731-32 (Fed. Cir. 1985).

The Examiner has not shown "adequate support in the prior art" for the change between the presently claimed compounds and the compounds of the '273 patent and the '938 patent.

The present Application, the'273 patent, and the'938 patent were, at the time the invention of the claimed invention in the present Application was made, owned by 3M Innovative Properties Company. Since the patents are prior art to the present Application only under § 102(e), and the present Application and the cited patents were commonly owned at the time the claimed invention was made, Applicant respectfully submits that under § 103(c) the subject matter of these patents "should not preclude patentability" under § 103.

Accordingly, withdrawal of this rejection is respectfully requested.

Double Patenting Rejection

The Examiner has rejected claims 2, 4, 14-28, 41-49, 73, 79, and 80 as being unpatentable over claim 1 of U.S. patent application, U.S.S.N. 12/092,65; claim 1 of U.S. patent application, U.S.S.N. 11/885,006; claim 1 of U.S. patent application, U.S.S.N. 11/885,005; an unspecified claims of U.S. patent application, U.S.S.N. 11/595,790; claim 3 of U.S. patent application, U.S.S.N. 11/570,716; an unspecified claim of U.S. patent application, U.S.S.N. 10/595,065; and an unspecified claim of U.S. patent application, U.S.S.N. 10/595,792. Applicant wishes to defer commenting on this rejection until it has matured into an actual rejection.

In view of the above amendments, applicant believes the pending application is in condition for allowance except for the provisional double patent rejections.

Please charge any unpaid fees associated with this Response, or credit any overpayments, to our Deposit Account No. 23/2825, under Docket No. C1271.70048US01, from which the undersigned is authorized to draw.

Dated: March 8, 2010

Respectfully submitted,

By /C. Hunter Baker/
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